

REMARKS

Applicants have amended **Fig. 5** to remove certain inconsistencies within originally filed **Fig. 5** and between originally filed **Figs. 5** and **6**. In particular, originally filed **Fig. 5** depicts certain portions of the sutures and lines partially depicting portions of the sutures extending over the outer surface of annular cuff 42'. See attached Fig. 5 (marked in red ink). As depicted elsewhere in **Fig. 5** and in **Fig. 6**, these sutures pass through the annular cuff 42'. Appl'n, Para. [0026]. In addition, Applicants are adding a new sheet of drawings including **Figs. 2-3** and **2-4**. These figures are substantially mirror images of the components depicted in **Figs. 2-1** and **2-2**. More specifically, the new figures represent a reflection or copy of **Figs. 2-1** and **2-2**, in which the left and right sides of the original are reversed. The views depicted in the new figures are fully described in the specification. Appl'n, Para. [0019] ("For example, first securing means 15 may be an annular lip and second securing means 25 may be a corresponding annular groove, or vice versa;" emphasis added); see also Appl'n, Claims 3, 14, 21, and 43. Applicants also are proposing corresponding amendments to the specification to refer to new **Figs. 2-3** and **2-4**.

Applicants maintain that in view of the existing figures and the existing written description in the specification of the embodiment shown in the new figures, the new figures are not "necessary for the understanding of the subject matter to be patented." See 35 U.S.C. §113. Nevertheless, because "the nature of the subject matter to be patented admits of illustration by a drawing without its being necessary for the understanding of the subject matter," Applicants are providing these new drawings for the Examiner's convenience. 37 C.F.R. § 1.81(c). These amendments are fully supported by the specification, and no new matter is added by these amendments. Applicants respectfully request entry of these amendments to the specification and drawings.

Applicant have amended the claims to clearly make claims 1 and 2 generic to each of the identified species. In addition, Applicants have added new claims 35-43. These amendments are fully supported by the specification, and no new matter is added by these amendments. Applicants respectfully request entry of these amendments to the claims.

In the Restriction Requirement mailed August 1, 2003, in the above-captioned patent application, Applicants are required to elect between five (5), allegedly, patentably distinct species for prosecution in this application. The Restriction Requirement identifies the following allegedly, patentably distinct species and claims, which Applicants believe to be associated with each species,:

<u>Species:</u>	<u>Associated Claims:</u>
Species I (Fig. 1)	Claims 1, 2, 4-13, 15-20, and 22-42
Species II (Fig. 2-1)	Claims 1-43
Species III (Figs. 2-2 thru 3-2)	Claims 1-43
Species IV (Figs. 4 and 7 thru 11)	Claims 1, 2, 4-13, 15-20, and 22-42
Species V (Fig. 5)	Claims 1, 2, 25-34, 39, and 40-42

The Restriction Requirement asserts that no claim is generic to all species. Nevertheless, Applicants maintain that amended claims 1 and 2 actually are generic to all species and that several other claims, e.g., claims 4-13, 15-20, and 22-42 are generic to two or more species, as indicated above. **Applicants elect to pursue Species I (Fig. 1; claims 1, 2, 4-13, 15-20, and 22-42), with traverse.**

According to the Manual of Patent Examining Procedures (MPEP), an election of species requirement is appropriate only when the species are shown to be distinct and when a “serious burden” would be placed on the Examiner to examine more than one species of the invention. See MPEP §§ 802.02, 803. “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” MPEP 803. MPEP § 803 provides that “[e]xaminers must provide reasons and/or examples to support conclusions . . . .” (Emphasis added.) In particular, according to MPEP § 808.02, “[w]here the related inventions as claimed are shown to be distinct under the criteria of [MPEP § 806.05(d)], the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following [accepted reasons]:” (A) Separate classification thereof, (B) Separate status in the art when they are classifiable together, and (C) A different field of search. (Emphasis added.) Applicants maintain that the Restriction Requirement fails to provide a reason approved by the Director demonstrating that a serious burden would be placed on the Examiner to examine more than one species of the claimed invention in this application. See MPEP 808.01(a) and 808.02. Because the Restriction Requirement merely asserts that the species are patentably distinct and fails to provide any reasons to justify the restriction or to establish a prima facie showing of a serious search and examination burden, Applicants maintain that this requirement for election is improper. In addition, each alleged species relates generally to automatic suture fixation apparatus. Consequently, the search of any of the elected species seems likely to uncover relevant art relating to the unelected species, and that any additional searching, which may be required, would not place a significant burden upon the Examiner. In view of the foregoing remarks, Applicants

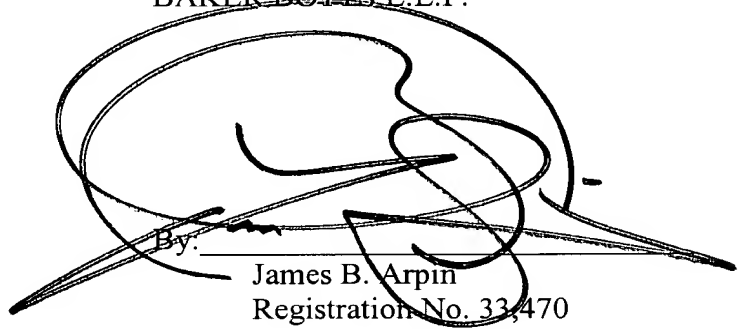
respectfully traverse the restriction requirement and requests that the Examiner reconsider and withdraw the election of species requirement.

Applicants are enclosing a check in the amount of \$114 covering the fees for entry of new claims 35-43. Nevertheless, in the event of any variance between the fees determined by Applicant and those determined by the U.S. Patent and Trademark Office, please charge any such variance to the undersigned's Deposit Account No. 02-0375.

Respectfully submitted,  
BAKER BOTTS L.L.P.

Dated: September 2, 2003

Baker Botts L.L.P.  
The Warner; Suite 1300  
1299 Pennsylvania Avenue, N.W.  
Washington, D.C. 20004-2400  
(202) 639-7700 (telephone)  
(202) 639-7890 (facsimile)

  
By: \_\_\_\_\_  
James B. Arpin  
Registration No. 33,470

JBA/dh

Attachments



Appl'n No. 09/987,976  
Amdt Dated Sept. 2, 2003  
Preliminary Amendment  
Annotated Sheet Showing Changes

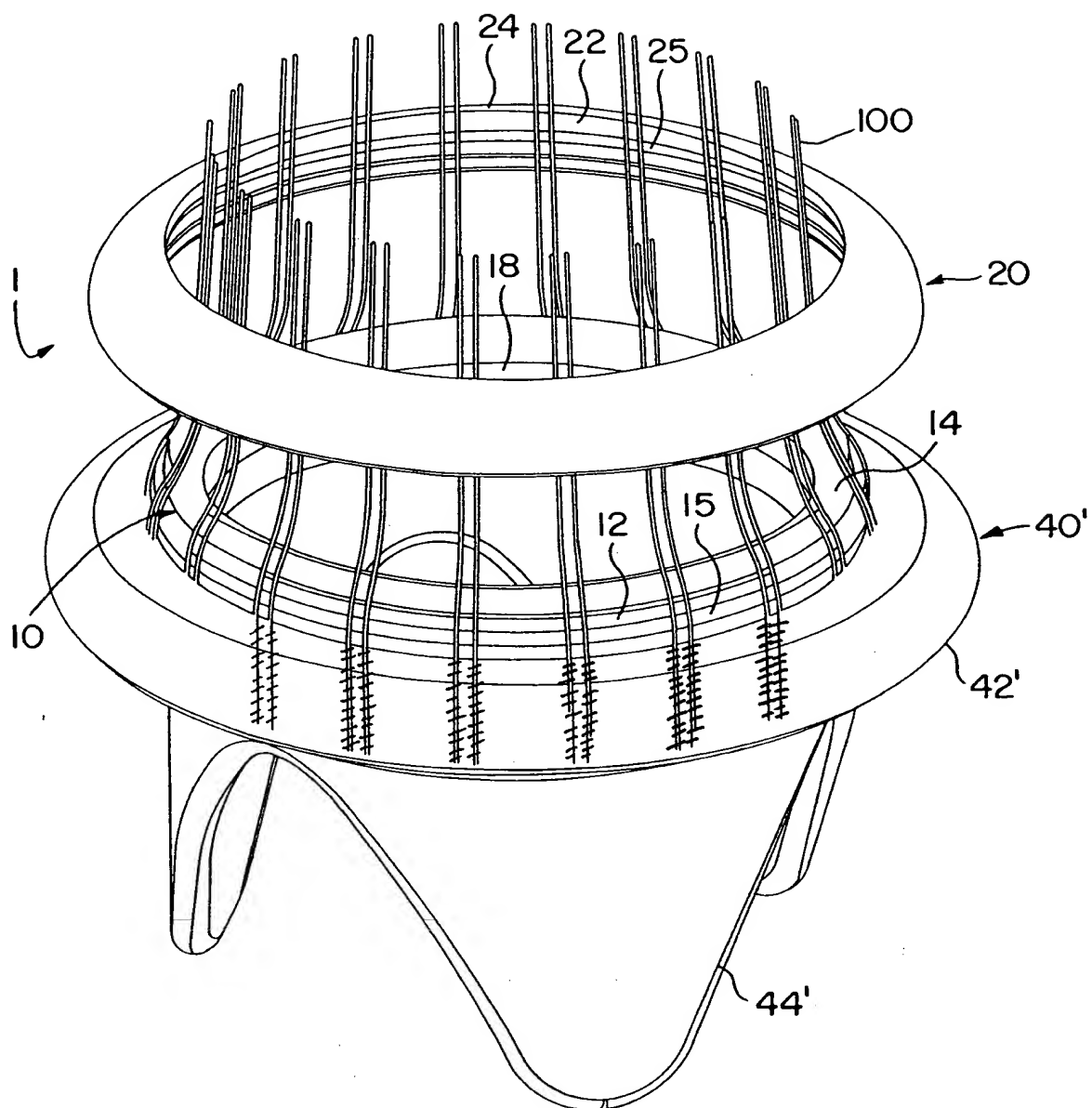


FIG. 5